

THIS DISPOSITION IS  
NOT CITABLE AS  
PRECEDENT OF THE TTAB

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BAC

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Magner Corporation of America, by merger with Magner  
Corporation<sup>1</sup>

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Serial No. 75/497,927

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Peter L. Costas of Pepe & Hazard, LLP for Magner  
Corporation of America, by merger with Magner Corporation.

Brendan Regan, Trademark Examining Attorney, Law Office 113  
(Odette Bonnet, Managing Attorney).

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Before Hanak, Chapman and Rogers, Administrative Trademark  
Judges.

Opinion by Chapman, Administrative Trademark Judge:

Magner Corporation of America (applicant) has appealed  
from the final refusal of the Examining Attorney to

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<sup>1</sup> The records of the Assignment Branch of the USPTO indicate that the original applicant, Magner Corporation, has merged into Magner Corporation of America. (Reel 2189, Frame 0134.)

register the mark shown below

***MAG II***

for "coin sorters; coin counters and verifiers sold singly and in combination, used for discrimination and counting of coins; coin packagers; paper currency counters; currency recognition and validation units; currency scales; computers and software for recording and reporting financial transactions" in International Class 9.<sup>2</sup>

The Examining Attorney has refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the basis of two registrations, both issued to Coin Acceptors, Inc., and both for goods identified as "vending machines and bill validators" in International Class 9 -- Registration No. 2,312,323, issued January 25, 2000, for the mark MAG, and Registration No. 2,354,001, issued May 30, 2000 for the mark shown below

**MAG**

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<sup>2</sup> Application Serial No. 75/497,927, filed June 8, 1998, based on applicant's assertion of a bona fide intention to use the mark in commerce.

(This registration includes a statement that the drawing is lined for the color red but color is not a feature of the mark.)

Briefs have been filed, and an oral hearing was held before this Board on March 14, 2002.

Preliminarily, we will address two evidentiary matters. First, the Examining Attorney requested in his brief that the Board take judicial notice of attached dictionary definitions of the terms "bill" and "currency." This request is granted. See *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). See also, TBMP §712.01.

Second, applicant submitted three exhibits with its brief and the Examining Attorney objected thereto, requesting that the exhibits be given no consideration. Exhibit A is simply a photocopy of the drawing page of applicant's application. (It was, of course, unnecessary for applicant to submit same as an exhibit.) Exhibit B consists of photocopies of literature about applicant's goods, and Exhibit C consists of printouts from a website "coinco.com" about registrant's goods.<sup>3</sup> With regard to the

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<sup>3</sup> There is no indication in the printouts that "coinco.com" is the website of registrant, Coin Acceptors, Inc. Nor is there any

latter two exhibits, during the ex parte prosecution applicant had previously stated that it had attached literature about both applicant and registrant. (See Applicant's August 17, 2000 Response to Second Office Action, p. 3.) Inasmuch as the Examining Attorney then assigned to this application did not make any mention of same nor indicate that the materials were not attached, the Examining Attorney's belated objection is overruled. The Board has considered applicant's exhibits attached to its brief on the case. Of course, as discussed more fully later in this decision, the Board must nonetheless consider the question of registrability in relation to the goods as identified.

Essentially, the Examining Attorney argues that the dominant feature of each mark is "MAG," and applicant's slight stylization of lettering and the addition of the Roman numeral "II" does not distinguish applicant's mark from registrant's marks; that the marks are highly similar in sound, appearance, connotation and commercial impression; that registrant's "bill validators" and applicant's "currency recognition and validation units" are

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record in the Assignment Branch of the USPTO that the cited registrations have been transferred to an entity named Coinco. Despite this fact, we have considered this evidence assuming that it is from registrant's website.

particularly highly related; and that any doubt on the issue must be resolved in registrant's favor.

Applicant argues that its mark is not MAG alone but includes a logo format and the registrant's marks are MAG alone and MAG in a logo format "clearly distinct" (brief, p. 4) from that of applicant. Applicant strongly urges that the goods are not related because registrant's goods ("bill validators") are component parts of vending machines or bill-changing machines sold to vending machine manufacturers, while applicant's "currency recognition and validation units" are complete machines utilized by and sold to financial institutions, armored car services and large retail establishments; and that neither applicant nor registrant sell to the general public, but rather, each entity's customers are sophisticated. Put another way, applicant contends that the parties' respective goods are sold in different channels of trade to different and sophisticated purchasers; and that merely because both companies' products process currency and coinage in some manner "does not mean that there is a likelihood of confusion between the goods." (Brief, p. 5.)

The salient question to be determined is not whether the goods of the parties are likely to be confused, but rather whether there is a likelihood that the public will

be misled to believe that the goods offered under the involved marks originate from a common source. See *J.C. Hall Company v. Hallmark Cards, Incorporated*, 340 F.2d 960, 144 USPQ 435, 438 (CCPA 1965); and *The State Historical Society of Wisconsin v. Ringling Bros.-Barnum & Bailey Combined Shows, Inc.*, 190 USPQ 25, 30 (TTAB 1976).

We affirm the refusal to register. In reaching this conclusion, we have followed the guidance of the Court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

In considering the respective marks, we find applicant's mark is similar in sound, appearance, connotation and commercial impression to the marks in each of the two cited registrations. The word or letter portion of each mark is "MAG." The dollar bill design, the underline in red and the stylized lettering in one of registrant's marks and the underline, the Roman numeral II and the stylized lettering in applicant's mark do not obviate any likelihood of confusion, especially in light of the fallible memories of consumers. See *Spoons Restaurants Inc. v. Morrison, Inc.*, 23 USPQ2d 1735 (TTAB 1991), *aff'd unpub'd* (Fed. Cir., June 5, 1992).

As acknowledged by applicant "the roman numeral II signifies a second version of several of the devices in the

product grouping." <sup>4</sup> (Applicant's July 22, 1999 Response to an Office action, p. 1). We agree that the marks MAG (registrant's mark) and MAG II (applicant's mark) will be perceived by the purchasing public as the related versions of a mark for variations in a product line. That is, purchasers may well assume that applicant's mark MAG II and design connotes the second generation of registrant's goods, the first generation of which are identified by the marks MAG and MAG and design.

Turning to a consideration of the involved goods, it is well settled that goods (and/or services) need not be identical or even competitive to support a finding of likelihood of confusion. It is sufficient that the goods are related in some manner or that the circumstances surrounding their marketing are such that they would likely be encountered by the same persons under circumstances that could give rise to the mistaken belief that they emanate from or are associated with the same source. See *In re Peebles Inc.*, 23 USPQ2d 1795, 1796 (TTAB 1992); and

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<sup>4</sup> The Board notes that applicant owns Registration No. 1,698,843, issued July 7, 1992, for the mark MAGNER for "coin sorters; coin counters and verifiers, and coin packagers, sold singly and in combination, used for discrimination and counting of coins; paper currency counters; currency scales; computers and software for recording and reporting financial transactions"; Section 8 affidavit accepted, Section 15 affidavit acknowledged.

Monsanto Co. v. Enviro-Chem Corp., 199 USPQ 590, 596 (TTAB 1978).

In determining the question of likelihood of confusion, the Board is constrained to compare the goods (and/or services) as identified in the application with the goods (and/or services) as identified in the cited registration(s). If the registrant's goods and the applicant's goods are described so as to encompass or overlap, then applicant cannot properly argue that, in reality, the actual goods of the applicant and registrant are not similar. See Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); and In re Continental Graphics Corp., 52 USPQ2d 1374 (TTAB 1999).

In this case, we shall focus our attention (as have both applicant's attorney and the Examining Attorney) on certain items in the respective identifications of goods, namely, applicant's "coin sorters; coin counters and verifiers...; paper currency counters; and currency recognition and validation units" and registrant's "bill validators."

It appears that "bill validators" in registrant's identification may be a term of art in the relevant field, and thus the Board will consider the evidence submitted

with applicant's brief (Exhibits B and C) in determining the question of the similarities/dissimilarities and nature of the respective goods. See *In re Trackmobile Inc.*, 15 USPQ2d 1152 (TTAB 1990). However, even considering this evidence, it does not establish, as applicant contends, that these goods, as identified, are distinct and unrelated. Applicant submitted photocopies of informational brochures about its "currency counter," "coin counter/packager" and "coin sorters"; as well as printouts of several pages from "coinco.com" which applicant states is "the Coin Acceptors' [registrant's] website." (Brief, p. 2.) The printouts from the coinco.com website include the following headings: "coin acceptors / bill acceptors / card readers / controllers / international." Moreover, the website printouts include statements such as the following:

Coinco is the dominant coin and bill acceptor brand in the world;

Together with the Coinco family of products, this acquisition [of Money Controls] has created the world's premier provider of products for automated transaction needs. The combined technologies provide coin changers, coin validators, bill acceptors and hoppers for any application in virtually every country of the world;

The company provides the world's largest variety of hoppers and validators for a diverse range of

markets including amusement, gaming and vending; and

Coinco continues to provide leading-edge coin and bill handling equipment that works harder and smarter for you.

The information presumably from registrant's website is not supportive of applicant's point. First, the website information does not utilize the term "bill validators" but rather uses the term "bill acceptors." Further, there is no clarification or explanation within the pages submitted by applicant establishing precisely what the involved term "validator" means in the industry.

Even if the very narrow definition of a bill validator urged by applicant had been shown (which it was not) it is not implausible that the registrant could begin making the more advanced, more complicated money handling equipment which is capable not only of validating a single denomination bill, but equipment that can first recognize the different denominations of currency and then validate same.

The record does show that one use of "Coinco's" products is with vending machines, but it also shows that these products are sold to a diverse range of markets including the amusement and gaming industries. Further, we do not read registrant's identification of goods --

"vending machines and bill validators" -- as limiting registrant's "bill validators" to only those which are a component part of a vending machine. The word "and" must be read in its common English meaning, that is, that registrant has registered its marks for the two items set forth in each of its identifications of goods. If registrant sold only a vending machine with a bill validator as a part thereof, presumably the identification of goods would so read.

There is no stated restriction in either party's identification of goods as to relevant purchasers. But, we agree that the general public would not generally purchase vending machines and or bill validators. Applicant's goods encompass numerous items, some of which are likewise not likely to be purchased by the general public (e.g., currency recognition and validation units, computers and software for recording and reporting financial transactions), but others (e.g., coin sorters) could conceivably include common small coin sorters sold to the general public. Even assuming that the relevant purchasers for both parties' identified goods would be sophisticated purchasers, that does not mean that they are totally immune from confusion as to the source of the goods and services. See *Wincharger Corporation v. Rinco, Inc.*, 297 F.2d 261,

132 USPQ 289 (CCPA 1962); and In re Decombe, 9 USPQ2d 1812 (TTAB 1988).

We agree with the Examining Attorney that the goods, as identified, are related; and applicant's evidence does not rebut the prima facie showing. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987).

Consumers familiar with registrant's "bill validators" sold under the marks MAG and MAG and design, would be likely to believe, upon encountering applicant's mark, MAG II and design, for, inter alia, "currency recognition and validation units" that the goods originated with or were somehow associated with or sponsored by registrant.

Any doubt on the question of likelihood of confusion must be resolved against the newcomer, as the newcomer has the opportunity of avoiding confusion and is obligated to do so. See TBC Corp. v. Holsa Inc., 126 F.3d 1470, 44 USPQ2d 1315 (Fed. Cir. 1997); and In re Hyper Shoppes (Ohio) Inc., 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988).

**Decision:** The refusal to register under Section 2(d) is affirmed as to both cited registrations.